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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,294	04/10/2001	Holger Eggers	MO-6277/WW-5	5941

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William C. Gerstenzang, Esq.  
Norris, McLaughlin & Marcus, P.A.  
220 East 42nd Street  
30th Floor  
New York, NY 10017

EXAMINER

RIBAR, TRAVIS B

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/807,294

Applicant(s)

EGGERS ET AL.

Examiner

Travis B Ribar

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed December 6, 2002 overcomes the rejections made under 35 USC 112, 101, and 102 put forth in the office action dated June 3, 2002.
2. The examiner maintains all rejections made in the office action dated June 3, 2002 under 35 USC 103 and the double patenting rejections.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on December 6, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of copending application 09/807094 has been reviewed and is NOT accepted.
4. The terminal disclaimer is drawn to the wrong instant case. The instant case should be 09/807294. Presently, the incorrect instant application 09/068322 appears on the terminal disclaimer.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164

Art Unit: 1711

USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-8 and 15 are provisionally rejected under the judicially created doctrine of double patenting over claims 2-8 and 10 of copending Application No. 09/807094. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. The office action dated June 3, 2002 contains the text of this rejection.

#### ***Claim Interpretation***

7. The examiner notes that the applicant amended claim 1 to include the limitations of newly cancelled claim 3. Therefore, any prior rejection that covered both of original claims 1 and 3 will now apply to newly amended claim 1.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1711

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2, 4, 10, 12-15, 17-21, and 23 are rejected under 35 U.S.C.

103(a) as being unpatentable over Khanna et al. in view of Mizutani et al.

The office action dated June 3, 2002 contains most of the text for this rejection.

The applicant claims a pure polyamide 6 layer in claim 17, which Khanna et al. discloses (column 7, line 44), along with additional fillers (claims 18-20) that Khanna et al. does not teach. Mizutani et al. teaches these fillers (column 12, lines 57-60), which inherently have the properties the applicant claims in claim 18. Further, Mizutani et al. also teaches that the fillers may be used in an amount that meets the restrictions of claim 21 (column 12, line 48). Regarding claim 23, this claim originates from the original claim 1, and the rejection in the office action dated June 3, 2002 addresses the limitation in this claim.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the nucleating agent in Mizutani et al. in the amount shown in the reference and at the disclosed temperature in the composition taught by Khanna et al. The motivation for doing so would be to create a suitably crystallized polymer that would be useful in food packaging applications.

Therefore it would have been obvious to combine Mizutani et al. with Khanna et al. to obtain the invention as specified in claims 1-2, 4, 10, 12-15, 17-21, and 23.

Art Unit: 1711

10. Claims 1-9, 11-21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramesh in view of the combined teachings of Khanna et al. and Mizutani et al.

The office action dated June 3, 2002 contains most of the text for this rejection.

The combination of Khanna et al. and Mizutani et al. regarding claims 17-21 and 23 is discussed above. The applicant claims a multilayer structure in claims 24 and 25 that mirror the combined requirements of claims 5-9, which are discussed in the rejection in the office action dated June 3, 2002 and are applied here as well.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the nucleating agent in Mizutani et al. in the amount shown in the reference and at the disclosed temperature in the composition taught by Khanna et al. in the multilayer structure in Ramesh. The motivation for doing so would be to create a suitably crystallized polymer that would be useful in food packaging applications. Therefore it would have been obvious to combine Mizutani et al. with Khanna et al. and Ramesh to obtain the invention as specified in claims 1-9, 11-21, and 23-25.

***Allowable Subject Matter***

11. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1711

12. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art is Mizutani et al., which discloses using a small amount of nucleating agent in the composition. Mizutani et al. does not, however, envision the use of such a small amount of nucleating agent as the applicant defines in claim 22. It is the examiner's position that the creation of the applicant's film using such a small amount of nucleating agent provides a novel and nonobvious contribution over the prior art.

#### ***Response to Arguments***

13. Applicant's arguments filed December 6, 2002 have been fully considered but they are not persuasive.

14. The applicant argues that the examiner's use of Mizutani et al. does not render the invention obvious because there is no mention of the nucleating agent's size and that the polymer in the reference is not the same as the polymer in Khanna et al. The examiner respectfully disagrees with both these points.

The claimed physical properties of the nucleating agent were held to be inherent properties of the nucleating agent and therefore present in Mizutani et al. The attached reference from [www.devicelink.com](http://www.devicelink.com) supports the examiner's position of inherency (see page 3, for example). In addition, Mizutani et al. discloses that the same polymer Khanna et al. uses is compatible with its

Art Unit: 1711

invention (column 11, line 26). The examiner therefore maintains his use of Mizutani et al. in the present context.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The



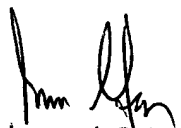
Art Unit: 1711

fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
January 15, 2003



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700